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SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV			EXAMINER	
P.O. BOX 2938			GARG, YOGESH C	
MINNEAPOLIS, MN 55402-0938				
			ART UNIT	PAPER NUMBER
			3625	
			NOTIFICATION DATE	DELIVERY MODE
			10/18/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[uspto@slwip.com](mailto:uspto@slwip.com)  
[request@slwip.com](mailto:request@slwip.com)

**Office Action Summary****Application No.**

09/003,457

**Applicant(s)**

JOSEPH ET AL.

**Examiner**

YOGESH C. GARG

**Art Unit**

3625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 165-185, 218-236, 247, 250, 252 and 256-261 is/are pending in the application.
- 5a) Of the above claim(s) 168-184, 221-235, 247 and 250 is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 165-167, 185, 218-220, 236, 252 and 256-261 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-SB/US)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 8/15/2011 has been entered.
2. Claims 165, 218, 252 and 260 have been amended.

### ***Response to Arguments***

3. Applicant's arguments, see page 13, filed 8/15/2011, with respect to rejection of claims under 35 USC 103 and 35 USC 251 have been fully considered and are persuasive. The rejection of currently amended claims 165-167, 185, 218-220, 236, 252, 256-261 under 35 USC 103 is now moot and withdrawn. The previous rejection of 165-167, 185, 218-220, 236, 252, 256-261 under 35 USC 251 has been also withdrawn.
4. However, the current amendment to independent claims 165, 218, 252, and 260 by removing the underlined words from the limitation " automatically retrieving personal information previously stored in a permanent memory in the client system , the retrieved personal information pertaining to a user associated with the client system" has

rendered the claims indefinite and not fully supported by the applicant's originally filed disclosure. Since the dependent claims do not come this deficiency all the claims 165-167, 185, 218-220, 236, 252, 256-261 pending for examination are subject to rejections under 35 USC 112, first and second paragraphs.

5. Claims 165-167, 185, 218-220, 236, 252, 256-261 are pending for examination.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 165-167, 185, 218-220, 236, 252, 256-261 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The current amendment to independent claims 165, 218, 252, and 260 includes removing the underlined words from the limitation " automatically retrieving personal information previously stored in a permanent memory in the client system , the retrieved personal information pertaining to a user associated with the client system", which has rendered the claims indefinite and not fully supported by the applicant's originally filed disclosure. The disclosed embodiment (see applicant's prior patent, col.8,

lines 52-col.9, line 2), recites following critical factors to implement the claimed inventions:

The personal information is stored **in a permanent memory in the client computer** [such as a set-top box of the TV] **and not external to the client computer** such that the user while viewing an item on TV screen wanting to order the item can press one button on the remote control. Pressing the button triggers appending the previously stored personal information from the permanent memory of the client with the item number currently being offered on the TV screen and transmitting the order to a central computer.

The claims, as recited, claim a broader scope than disclosed. The claim language of claims encompasses that the personal information can be stored in a memory which could be external to the client such as an external server [a memory in a server when in communication with a client is also associated with the client] and that would imply not appending the personal information from the permanent memory in the client at the time of selecting a currently offered item using the client computer. Storage of personal information in the open server environment is not originally disclosed or enabled and did not form part of invention as originally filed. At the time of the applicant's invention one of an ordinary skilled in the art would not have viewed open server environment disclosed to have been able to maintain the security of the personal information anywhere in the network other than as resident in the client computer memory to append this personal information with an item number at the time when user

presses a button on a remote TV module to order a currently displayed viewing information on screen and selects the item.

The applicant's attention is also invited to MPEP 2163.05 Changes to the Scope of Claims [R-2], " The failure to meet the written description requirement of 35 U.S.C. 112, first paragraph, commonly arises when the claims are changed after filing to either broaden or narrow the breadth of the claim limitations, or to alter a numerical range limitation or to use claim language which is not synonymous with the terminology used in the original disclosure. To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. See MPEP § 2163 for examination guidelines pertaining to the written description requirement.

## **I. BROADENING CLAIM**

### **Omission of a Limitation**

A claim that omits an element which applicant describes as an essential or critical feature of the invention originally disclosed does not comply with the written description requirement. See *Gentry Gallery*, 134 F.3d at 1480, 45 USPQ2d at 1503; *In re Sus*, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962) ..... ".

In the present case, the claims as recited omit essential elements/critical features of the invention as explained above and therefore do not comply with the written description requirement.

8. Since the dependent claims do not come this deficiency all the claims 165-167, 185, 218-220, 236, 252, 256-261 pending for examination are subject to rejection under 35 USC 112, first paragraph for the same reasons, as above.

9. Claims 165-167, 185, 218-220, 236, 252, 256-261 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The current amendment to independent claims 165, 218, 252, and 260 includes removing the underlined words from the limitation " automatically retrieving personal information previously stored in a permanent memory in the client system , the retrieved personal information pertaining to a user associated with the client system", which has rendered the claims indefinite and not fully supported by the applicant's originally filed disclosure. The disclosed embodiment (see applicant's prior patent, col.8, lines 52-col.9, line 2), recites following critical factors to implement the claimed inventions:

The personal information is stored **in a permanent memory in the client computer** [such as a set-top box of the TV] **and not external to the client computer** such that the user while viewing an item on TV screen wanting to order the item can press one button on the remote control. Pressing the button triggers appending the previously stored personal information from the permanent memory of the client with the

item number currently being offered on the TV screen and transmitting the order to a central computer.

The claims, as recited, claim a broader scope than disclosed. The claim language of claims encompasses that the personal information can be stored in a memory which could be external to the client such as an external server [a memory in a server when in communication with a client is also associated with the client] and that would imply not appending the personal information from the permanent memory in the client at the time of selecting a currently offered item using the client computer. Storage of personal information in the open server environment is not originally disclosed or enabled and did not form part of invention as originally filed. At the time of the applicant's invention one of an ordinary skilled in the art would not have viewed open server environment disclosed to have been able to maintain the security of the personal information anywhere in the network other than as resident in the client computer memory to append this personal information with an item number at the time when user presses a button on a remote TV module to order a currently displayed viewing information on screen and selects the item. Therefore, the claims as recited contain subject matter, that is storing the personal information in a memory external to client, in an open server environment which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.



10. Since the dependent claims do not come this deficiency all the claims 165-167, 185, 218-220, 236, 252, 256-261 pending for examination are subject to rejection under 35 USC 112, first paragraph for the same reasons, as above.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 165-167, 185, 218-220, 236, 252, 256-261 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The current amendment to independent claims 165, 218, 252, and 260 includes removing the underlined words from the limitation " automatically retrieving personal information previously stored in a permanent memory in the client system , the retrieved personal information pertaining to a user associated with the client system", which has rendered the claims indefinite and not fully supported by the applicant's originally filed disclosure.

13. Claims 165-167, 185, 218-220, 236, 252, 256-261 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

The omitted elements are:

The disclosed embodiment (see applicant's prior patent, col.8, lines 52-col.9, line 2), recites following critical factors to implement the claimed inventions:

The personal information is stored **in a permanent memory in the client computer** [such as a set-top box of the TV] **and not external to the client computer** such that the user while viewing an item on TV screen wanting to order the item can press one button on the remote control. Pressing the button triggers appending the previously stored personal information from the permanent memory of the client with the item number currently being offered on the TV screen and transmitting the order to a central computer. The claims, as recited, do not include the above critical features.

14. Since the dependent claims do not come this deficiency all the claims 165-167, 185, 218-220, 236, 252, 256-261 pending for examination are subject to rejection under 35 USC 112, second paragraph for the same reasons, as above.

### ***Specification***

15. The amendment filed 8/15/2011 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The current amendment to independent claims 165, 218, 252, and 260 includes removing the underlined words from the limitation " automatically retrieving personal information previously stored in a permanent memory in the client system ,the retrieved personal information pertaining to a user associated with the client system", which has rendered the claims indefinite and not fully supported by the applicant's originally filed disclosure. The disclosed

embodiment (see applicant's prior patent, col.8, lines 52-col.9, line 2), recites following critical factors to implement the claimed inventions: The personal information is stored **in a permanent memory in the client computer** [such as a set-top box of the TV] **and not external to the client computer** such that the user while viewing an item on TV screen wanting to order the item can press one button on the remote control. Pressing the button triggers appending the previously stored personal information from the permanent memory of the client with the item number currently being offered on the TV screen and transmitting the order to a central computer. The claims, as recited, do not include the above critical features.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOGESH C. GARG whose telephone number is (571)272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YOGESH C GARG  
Primary Examiner  
Art Unit 3625

/YOGESH C GARG/  
Primary Examiner, Art Unit 3625